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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/956,991	10/23/1997	JULIE R. KORENBERG	P-CE-2817	9464
34055	7590	03/24/2004		
PERKINS COIE LLP POST OFFICE BOX 1208 SEATTLE, WA 98111-1208			EXAMINER SWITZER, JULIET CAROLINE	
			ART UNIT	PAPER NUMBER
			1634	

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action

Application No.

08/956,991

Applicant(s)

KORENBERG, JULIE R.

Examiner

Juliet C. Switzer

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


JEFFREY FREDMAN
PRIMARY EXAMINER

Continuation of 3. Applicant's reply has overcome the following rejection(s): Written Description Rejection of claims 33-37 and 49. The cancellation of these claims renders the rejection moot.

The utilities provided by applicant which might provide an "identifiable benefit" as suggested by applicant are not considered substantial utilities, because as previously noted in the rejection and previously set forth arguments, these utilities would require further experimentation in order to reasonably confirm that they are applicable to the claimed invention.

Applicant refers to page 10 of the specification which discusses that the "expression pattern and role of dendritic connection in cell body maintenance indicate that an increase in DS-CAM expression in DS brain is responsible for the abnormalities of dendritic structure and decreased intersections seen at four months post-natal in DS individuals," however the specification does not provide an showing of a differential expression of DS-CAM in DS individuals. This statements in the specification is a speculation of a possible role of DS-CAM in downs syndrome. In order to reasonably use the molecule for an diagnostic or therapeutic function related to this assertion, one would be required to undertake further experimentation to reasonable confirm the relationship between the molecule and disease. Applicants own arguments underscore the fact that the precise role of the DS-CAM is unknown stating that the evidence in the specification points to the role of DS-CAM in a wider variety of possible functions- "neural development, Down Syndrome and 'other' nerual disorders." Applicant asserts a role of the molecules in the treatment of Down Syndrome, yet clearly further experimentation would be required to reasonably confirm this utiltiy as no guidance for such a utility is provided in the specifcaiton.

Applicant furtehr notes that the molecules have a well known utility as a diagnostic marker for Down Syndrome and HPE1, however, a review of the literature did not identify such a well known utility for the nucleic acid molecules.